

REMARKS

Claims 7-12 remain in the present application. Claim 7 and 12 was amended in this response. No new matter has been introduced as a result of the amendment. Support for the amendments may be found, for example, on page 4, second paragraph, page 6, second full paragraph, and page 7 of the originally filed specification. Favorable reconsideration is respectfully requested.

Claims 7 and 9-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Westberg* (US Patent 6,041,054) in view of *Suzuki* (US Patent No. 6,330,239). Claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Westberg* (US Patent 6,041,054) in view of *Suzuki* (US Patent No. 6,330,239), and further in view of *Bharucha et al.* (US Patent 6,229,821). Applicants respectfully traverse this rejection.

Applicants wish to request a telephonic Examiner Interview to discuss the present amendment and response and to clarify ambiguities in the Office Action. Specifically, the present claims recite the term "exchange" which has been interpreted as a switching device, such as a PBX. However, the Office Action uses this term inconsistently (e.g. page 3, 3rd paragraph, "an exchange of the IP over ATM network connections"). The Examiner is kindly asked to contact the undersigned to identify a convenient time period in which the Applicant may schedule an interview with the Examiner.

Regarding the cited documents, none of the cited references, alone or in combination, teach or suggest subdividing the Internet Protocol data packets into substructure elements, or "inserting, via the transmitting conversion device, the substructure elements into the subdivided Internet Protocol data packets unchanged, wherein no compression or decompression of the voice data is performed; transmitting the Internet Protocol data packets from the transmitting conversion device to a receiving conversion device; [and] extracting, via a receiving conversion device associated with a receiving one of the connecting exchanges, the substructure elements from the received Internet Protocol data packets, wherein no compression or decompression of the voice data is performed" as recited in claim 7. The recited method generally discloses steps for transparently transmitting data in the form of substructure elements through a packet-oriented communication network using IP data packets (e.g., transmission of ATM cells over an IP network.).

In contrast Westberg teaches that IP data packets get transmitted through an ATM network (col. 3, lines 5-7), which is the opposite of the claimed configuration. Westberg also does not teach or suggest an inserting of the substructure elements (cell header and payload) into IP data packets unchanged, and further relies on compression/decompression in transmitting packet data (col. 7, lines 1-12). In Fig. 2 of Westberg, the reference discloses different size AAL2 minicells in the top row compared to the bottom row, whereas differently sized cells in the top row appear as same sized blocks in an ATM cell (e.g. third AAL2 minicells from the right and second AAL2 minicells from the right are clearly different in size in the top row but roughly the same size in the bottom row). Accordingly, the AAL2 minicells will not stay unchanged when they get inserted into an ATM cell.

Suzuki also fails to solve the deficiencies of Westberg, discussed above, and fails to teach or suggest the amended features of the present claims. Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Westberg* and Suzuki references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

As discussed above, the entire disclosure of Westberg is directed to the transport of IP data packets over a single ATM connection, specifically using the AAL2 adaption layer (col. 1, lines 1-14; col. 3, lines 5-12). In contrast, Suzuki teaches an address converter for the IPv6 standard for extracting logical address information from a datagram received from an Internet

protocol computer network through a data transmission path and converting the extracted address information into absolute address information of an ATM network, having a geographically hierarchical structure (col. 2, lines 49-61; col. 3, lines 1-10). Also, Suzuki teaches extracting address information from an ATM cell that is received from an asynchronous transfer mode network through a data transmission path and converting the address information into absolute address information in an Internet protocol computer network corresponding to the extracted logical address information and adding the converted address information to the original datagram (col. 3, lines 21-30). The conversions are used to resolve address differences that exist in the IPv6 protocol. However, none of these features are remotely addressed in Westberg, and Applicant respectfully submits that the two systems are wholly incompatible, as each document is directed to a completely different mode of communication. How specifically would Westberg operate using the conversions of Suzuki, when Westberg relies on particular mapping of sessions and protocols via look-up tables (col. 6, lines 22-45; col. 7, lines 44-59)? Applicant cannot understand how such a combination is tenable, given the teaching in each document. For at least these reasons, the Applicants respectfully submit the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

In light of the above, Applicants respectfully submit that independent claim 7 of the present application, as well as claims 8-12 which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

It is further submitted that no fees are due in connection with this response at this time. However, if any fees are due in connection with this application as a whole, the Examiner is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-177) on the account statement.

Respectfully submitted,

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